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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,238

02/26/2004

Phillip L. Lam

PERFECT-1/CIP-2

7970

1054

7590

06/27/2007

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EXAMINER

MICHALSKI, SEAN M

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

06/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/789,238	Applicant(s) LAM, PHILLIP L.	
	Examiner Sean M. Michalski	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/14/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/14/2007 has been entered.

### ***Drawings***

The replacement drawings are accepted as submitted.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2-5 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunter et al. (2,299,627).

Hunter discloses a manicuring implement (figures 1 and 5) including an elongated member (handle 12 or 12a figure 1 or 5 respectively), a proximal member (10, 18, 14 figure 1) coupled to the first end of the elongated member (figure 1) including an arcuately formed wall member (tip of 26 figure 1, or alternatively 30 or 27 figure 4, or alternatively 43 figure 5 may be considered a wall member) and an arcuately

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formed blade member (24a figure 2) being adjacent to one another and at 'a first end' of the proximal member (see figures). Each of the blade and wall extend "transverse" (or across, or perpendicular to) a horizontal axis of the proximal member. The horizontal axis may be the axis that is axial with cylinder 10, or may extend up and down in the plane of figure 1, or be perpendicular to the plane of the page of figure 1, since each would allow the blade and each of the walls to be interpreted as being 'transverse' thereto. Hunter further discloses a "distal member releasably coupled to said second side of said elongated member", 41 figure 5 is such a "distal member" since it may be "press fitted or otherwise attached". A plastic "press fitted" is releasably coupled, since it may be released.

Regarding claim 3, the blade is removable from the other components of the proximal member (see figure 4 which shows the blade alone, and figure 2 which shows the removable cap in detail). Alternatively, the movement of the blade from a retracted position in figure 2 to an extended position in figure 1 *would* meet the limitation "removably displaceable" since it is being removed from the proximity to the other components of the proximal member, and it is being displaced (moved from one location to another).

Regarding claim 4, 32a may be considered a retention cap. Alternatively 43 may be considered a retention cap since it prevents the tip form being actuated or moved, it blocks fingers from coming into contact with the blade 22/24. It therefore secures in place the blade. Alternatively the spring 35 figure 1 is a retention cap, since it secures the blade against the stop 32.

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Regarding claim 5, the distal member includes a pusher (the rounded blunt end of 41 is a pusher) for shaping and preparing a cuticle for cutting. It has been held that the recitation that an element be "for" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Examiner has used a blunt rounded edge to flatten out, or smooth a cuticle in preparation for cutting, and so the blunted tip of 41 clearly meets the limitation that the 'pusher' be capable of 'preparing' a cuticle for cutting. If the limitation had been more concrete, such as requiring that the pusher be able to separate a cuticle away from a human finger nail this interpretation would not have been acceptable, but 103 rejections may still have been possible.

Regarding claim 13, the cavity which extends within 12, from the first to second ends constitutes a "hollow cavity at first and second ends thereof".

***Claim Rejections - 35 USC § 103***

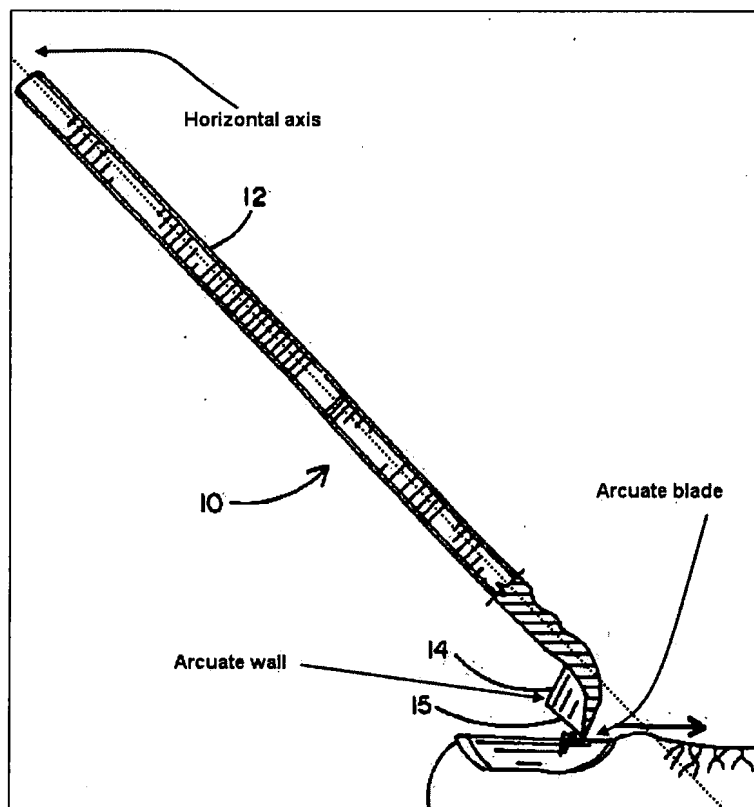
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baltierra in view of either one of Hart (1,476,508) and Henkel (1,113,168) further in view of Volinsky (US 5,342,379) and Parmley ("Plastic Snap Fit..." pp. 20-28 and 20-29).

The level of ordinary skill in the art is considered to be a person with a B.S. degree in Mechanical engineering, a closely related field or possession of equivalent work experience, as indicated by the quality, nature and extent of the cited references. Additionally, Examiner takes official notice of the fact that a person of ordinary skill in the art would possess a B.S. degree in Mechanical engineering, a closely related field or have equivalent work experience.

Baltierra teaches a manicuring tool with a proximal member and an elongated member, the proximal member having an arcuate wall and an arcuate blade, both extending transverse (across) to the horizontal axis (the axis of the entire tool, and of the proximal member is a horizontal member) of the proximal member. Also see the figure below:



Although the claim limitation "releasably coupled" does not preclude Baltierra (since the proximal and distal members thereof could be sawed off- thus they are releasably coupled), in order to advance prosecution, this interpretation will not be relied on.

Baltierra does not teach a manicuring tool with an implement at the distal end.

Hart teaches a two sided manicuring implement having a blade on one end thereof (the proximal end, d /b figure 1 and 2; also page 1, column 2, lines 70 and 71) and a pusher I on the distal end (page 1, column 1, lines 51 and 52).

Henkel teaches a manicure tool with a pusher tip at the distal end (12 figure 1 ) and a cutter at the opposite end (19 figure 2, page 1 column 2 line 93).

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Baltierra by having manicuring blade at one end, and a manicuring pusher at the other end as taught by *both* Henkel and Hart. The motivation to combine is that providing a double ended tool is more convenient than having two separate tools.

Baltierra in view of Hart and Henkel does not teach a designed removability of each tool from the elongated member (handle). Baltierra in view of Hart and Henkel does not teach specifically, that the removable portions be separable by a pair of apertures at each disconnection point, or that there are a pair of probes protruding from the second end of the proximal member (the member having the blade) and distal member (the member having the pusher), each probe having a securing tab projecting therefrom, wherein the pair of probes is received in said hollow cavity and each tab is

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received in respective apertures when the proximal or distal member is coupled to the elongated member (respectively).

Volinsky discloses a releasable proximal portion (20 figure 1) which carries a blade at the first end (seen clearly in figure 1) and has two probes (66 figure 1) with two respective tabs (68 figure 1) which may be inserted into respective hollow cavities (16 figure 1) with respective apertures (18 figure 1). The tabs may also be called retention caps.

Parmley teaches that snap-fit connections are applicable to a wide variety of mechanical connections and there are generic formulas that are useable by one of ordinary skill in the art. Parmley is a generic reference showing the level of sophistication that would be held by one of ordinary skill in the art in the selection and application of snap-fit connections. Parmley also indicated some extremely persuasive reasons to select a snap-fit *above* other connectors, such as press fit (as seen in Hunter et al. above) screw fit (also shown in Hunter et al.) and a sonic weld (another known connection). See lines 12-15 of the first column on pp. 20-28. Parmley also shows a common snap-fit connection between two components in the figure on pp 20-28, where the land angle is 30 degrees and the return angle is 90 degrees, and the part with the two "probes" is inserted into a single cavity, that has two apertures for each of the tabs respectively at the end of each probe (to use applicants terminology). Clearly the use of dual probe, with dual tab, connections is known *generally* (Parmley) in addition to within the art (Volinsky).



In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Baltierra in view of either Hart or Henkel by providing for removability of both the proximal member (blade) and distal member (pusher) as taught by Volinsky. The motivation to combine is that in blood borne pathogen environments (such as surgery or manicure) disposal of the portions of equipment which come into contact with blood or other human fluids is desirable, and in some locations legally mandatory. By using a cartridge and permanent handle, waste is minimized, since the permanent handle may be reused, while the cartridge may be disposed of. This configuration "reduce[s] cost and decrease[s] medical waste" (column 1 lines 52-54). Additionally, separability by tab/probe configuration is desirable above screw on (which can loosen through vibration) and press fit (since that depends on friction and strain to maintain hold), whereas a snap fit can be designed to have "a pull-out force...hundreds of times larger than the push-in force." (Parmley column 1 lines 17-19), which is desirable since it prevents unwanted disconnections.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claim 2 has been considered but is moot in view of the new ground(s) of rejection. Additionally applicant has only argued the patentability of claim 2, relying on this underlying claim for the patentability of all dependent claims (3-5 and 13-16).

#### ***Conclusion***

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMM



KENNETH E. PETERSON  
PRIMARY EXAMINER